

REMARKS

Applicants have carefully considered the November 16, 2005 Office Action, and the amendments above together with the comments that follow are presented in a bona fide effort to address all issues raised in that Action and thereby place this case in condition for allowance. Claims were pending in this application. Claims 16-23 have been withdrawn from consideration pursuant to the provisions of 37 C.F.R. § 1.142(b). Applicants respectfully request rejoinder of Group II (claims 16-23), which are directed to a method of vapor depositing a lubricant film, upon the allowance of any of the claims in Group I in accordance with the rejoinder provisions of M.P.E.P. §§ 821.04 and 806.05(e).

In response to the Office Action dated November 16, 2005, claims 24-27 have been canceled. Applicants submit that the present Amendment does not generate any new matter issue. Entry of the present Amendment is respectfully solicited. It is believed that this response places this case in condition for allowance. Hence, prompt favorable reconsideration of this case is solicited.

Claims 1-15 and 25-27 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 6,613,151 (hereinafter the '151 Patent). This rejection is traversed. Claims 25-27, as well as claim 24 have been cancelled and, therefore, the rejection is moot with respect to these claims. As for claims 1-15, Applicants respectfully request that the Examiner hold this rejection in abeyance until allowable subject matter is obtained in the present application.

Claims 1-15 and 24-27 were rejected under 35 U.S.C. § 103(a) for obviousness predicated upon Brauer et al. (U.S. Pat. No. 6,241,824, hereinafter "Brauer") in view of Dick et al. (U.S. Pat. No. 5,904,958, "Dick"). Claims 24-27 have been cancelled and, therefore, the rejection is moot with respect to these claims. Claims 1-15 are free from the applied art for the reasons set forth below.

As described in the present specification, the claimed invention relates to an apparatus for uniformly applying a thin film of a lubricant to substrate surfaces in a solventless manner. The invention has particular utility in the manufacture of magnetic or magneto-optical ("MO") data/information storage and retrieval media comprising a layer stack or laminate of a plurality of layers formed on a suitable disc-shaped substrate, wherein a thin lubricant topcoat is applied to the upper surface of the layer stack or laminate for improving tribological performance of the media when utilized with read/write transducers operating at very low flying heights (page 1 of the specification, lines 5 through 14). The present invention addresses and solves problems and difficulties in achieving uniform thickness lubricant thin film deposition by providing an inventive apparatus for vapor depositing a uniform thickness thin film of a lubricant on at least one surface of a disc-shaped substrate which contains a magnetic and/or MO data/information storage and retrieval media (page 5 of the specification, lines 10 through 18).

Independent claim 1 is directed to an apparatus comprising elements which are structured and positioned to vapor deposit a uniform thickness thin film of a lubricant on at least one surface of a disk-shaped substrate. The claimed apparatus comprises a chamber having an interior space; and a substrate loader/unloader. The claimed apparatus further comprises at least one elongated lubricant vapor source comprising a closed heated chamber which contains a liquid lubricant, said closed heated chamber fluidly communicating with at least a plurality of primary plugs for supplying a stream of lubricant vapor. The claimed apparatus also comprises a substrate transporter/conveyor which continuously moves at least one said disk-shaped substrate past said stream of lubricant vapor from said at least one elongated lubricant vapor source for depositing on at least one surface thereof a uniform thickness thin film of lubricant.

Applicants submit that Brauer and Dick are not within the same field of endeavor, and that one of ordinary skill in the art would not have been realistically motivated to combine the references, as proposed by the Examiner. One skilled in the art confronted with the problem of Brauer (provide

layers to spherically shaped objects, such as eyeglasses, in one continuous process with uniform thickness – col. 2, lines 16-21) would not look to Dick to solve their problem, because Dick is not reasonably pertinent to the particular problem addressed by Brauer. Dick is concerned with evaporation of organic monomers at high temperatures to minimize the effect of thermal expansion upon cross-direction coating uniformity; the substrate being a continuous sheet of material such as wood or metal). See col. 1, lines 50-54; col. 3, lines 50-55. Similarly, one skilled in the art would not have found either Brauer or Dick reasonably pertinent to the particular problem with which the present claimed invention is involved, namely, the vapor deposition of a uniform thickness thin film of a lubricant on at least one surface of a disc-shaped substrate comprising a magnetic and/or MO data/information storage and retrieval media. The very notion of coating a magnetic medium is not even on the radar screen of Brauer or Dick, let alone with a lubricant. The apparatus disclosed by Brauer or Dick is not structured to and is not capable of vapor depositing a uniform thickness thin film of a lubricant on at least one surface of at least one disk-shaped substrate having a magnetic or magneto optical data/information storage and retrieval media. The Examiner is also charged to consider "'the reality of the circumstances' ... in other words, common sense" to determine what field a person of ordinary skill in the art would reasonably be expected to look. *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). With regard to this issue, the Examiner is also referred to M.P.E.P. § 2141.01(a), entitled "Analogous and Nonanalogous Art." In view of the foregoing, the inescapable conclusion is that Brauer and Dick are non-analogous prior art that cannot be applied against the claimed invention. Accordingly, the rejection is not legally viable for at least this reason.

Moreover, the Examiner has failed to explain why one of ordinary skill in the art would have been motivated to combine the apparatus of Brauer which coats eyeglass lenses on transport arm carriers having rotational axes, with the apparatus of Dick which vapor deposit organic monomers such as polyfunctional acrylic monomers on moving, continuous sheets of paper or metal. Applicants respectfully submit that the Examiner is merely picking and choosing the limitations of the prior art to

back into the present invention without the requisite motivation. In the instant case, the Examiner's announced motivation is nothing more than a generalization. The Examiner merely asserts that one of ordinary skill in the art would have been motivated to modify Brauer's apparatus with Dick's adjustable evaporator with nozzles plugs because it would allegedly offer "better control of deposition material." However, the Examiner fails to explain how the proposed modification would be implemented. Applicants submit that the Examiner has the burden of making a "thorough and searching" factual inquiry to support the conclusion that a person of ordinary skill in the art would have been motivated to combine the references so as to arrive at the claimed invention. *In re Lee*, 237 F.3d 1338, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). The Examiner offers no such factual inquiry to support the conclusion. It is not readily apparent, and the Examiner has not at all explained, how Brauer's apparatus, including multiple rotatable substrate (eyeglass) carriers and loading/unloading stations, could be modified with Dick's evaporator that is adapted to vapor deposit monomer material to a continuous sheet of material such as wood or metal. Accordingly, the rejection should be withdrawn for at least this reason.

It is believed that all pending claims are now in condition for allowance. Applicants therefore respectfully request an early and favorable reconsideration and allowance of this application. If there are any outstanding issues which might be resolved by an interview or an Examiner's amendment, the Examiner is invited to call Applicants' representative at the telephone number shown below.

Application No.: 10/644,054

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP



Brian K. Seidleck  
Registration No. 51,321

600 13<sup>th</sup> Street, N.W.  
Washington, DC 20005-3096  
Phone: 202.756.8000 BKS:idw  
Facsimile: 202.756.8087  
**Date: February 16, 2006**

**Please recognize our Customer No. 49745  
as our correspondence address.**